

Application No. 10/721,358

Docket No.: 1020/0132PUS1

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REMARKS

FEB 29 2008

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 1-21 are pending in the present application, with claims 1 and 11 being independent.

Claims 20 and 21 have been withdrawn by the Examiner as allegedly being directed to a non-elected invention.

Specification

Applicants respectfully submit that no corrections are believed necessary to the specification at this time.

Claim Objections

The Examiner objected to claims 1, 11, 15, and 16. Particularly, the Examiner stated that "[i]t has been held that the recitation that an element is "adapted to", "design to", and "able to" perform a function is not a positive limitation but only requires the ability to so perform. ... Appropriate correction is required." See Office Action at page 2.

However, Applicants respectfully direct the Examiner to M.P.E.P. § 2111.04, which states that:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

(A) "adapted to" or "adapted for" clauses;

(B) "wherein" clauses; and

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(C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*<

See M.P.E.P. § 2111.04; emphasis added.

Accordingly, the Examiner's position is not understood. Moreover, even assuming in *arguendo* that such phrases may not be given patentable weight, it is unclear what correction the Examiner deems necessary, as there clearly is nothing wrong with reciting such phrases.

For at least the foregoing reasons, no correction is believed necessary and the Examiner is requested to reconsider and withdraw this objection.

Election/Restriction

The Examiner alleged that:

Newly submitted claims 20-21 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: because of a different field of search (e.g., class/subclass) where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-21

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withdrawn from consideration as being directed to a non-elected invention.
See 37 CFR 1.142(b) and MPEP § 821.03.

See Office Action at pages 2-3; emphasis added.

Applicants respectfully submit, however, that the Examiner's position is not understood, for at least the following reasons. Therefore, Applicants respectfully traverse this election/restriction requirement.

First, the Examiner has not identified the alleged different field of search (e.g., class/subclass). Thus, Applicants respectfully submit that the election/restriction fails to meet the minimum requirements for restricting the claims.

Second, Applicants note that claims 20 and 21 further define the features of the claimed "light rotor", as recited in independent claim 1. Thus, it is unclear how the features of claims 20 and 21 properly can be considered to require a different field of search (e.g., class/subclass) from independent claim 1.

Third, Applicants respectfully submit that claims 20 and 21 clearly distinguish over the prior art of record. Applicants respectfully submit that the necessity of updating the prior art search because the claims clearly distinguish over the prior art of record is not the same as requiring a different field of search.

For at least these reasons, Applicants respectfully submit that the Examiner properly should have considered the features of claims 20 and 21, which were added by the Amendment under 37 C.F.R. § 1.111. Applicants also respectfully submit that the Examiner properly should have updated the prior art search and examined claims 20 and 21 for the patentability.

Accordingly, the Examiner is requested to reconsider and withdraw this restriction requirement, and properly Examiner claims 20 and 21.

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If the Examiner maintains the restriction requirement, the Examiner is requested to properly identify the different filed of search, including the class and subclass, which forms the basis for restricting claims 20 and 21.

Claim Rejections under 35 U.S.C. §102

Claims 1, 4-9, and 17 stand rejected under 35 U.S.C. 102(e) as being anticipated by Zysnarski et al. (US 6,590,174). This rejection is respectfully traversed insofar as it pertains to the presently pending claims.

Independent claim 1 recites a control element comprising:

a combined scale and corona illumination, wherein the scale is a part of a panel that is designed to work together with the control element;

an optical light guide formed from a single piece that includes two parts, the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot;

a light rotor that extends towards the optical light guide to a height necessary for light transport; and

a light source located below the light rotor. (Emphasis added.)

As exemplarily illustrated in Fig. 2, the subject application discloses that the light from the light source 9 located below the light rotor 7 is transported through the light rotor 7 into the upper region, where it is coupled to the optical light guide 6 for backlighting or illumination of the scale 3 and the corona 5. See, e.g., specification at page 3, paragraph [0017].

Zysnarski is distinguished from the above quoted feature in that Zysnarski clearly fails to show at least "a light rotor that extends towards the optical light guide to a

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height necessary for light transport; and a light source located below the light rotor" as recited in claim 1 (emphasis added), for at least the following reasons.

Zysnarski specifically discloses that switch assembly 40 is configured such that the light which is emitted from the light sources 22 is emitted from the gap 38, which surrounds the knob 14, so that the knob 14 appears to be floating on the light. See col. 5, lines 14-16. Zysnarski does not disclose that the knob 14 itself transports light from the light sources 22, or for that matter, that the knob 14 extends toward the light diffuser 16, which the Examiner compares to the claimed optical light guide, to a height necessary for light transport. Instead, Zysnarski specifically discloses that an interior surface 58 of the knob 14 reflects light, which then ends up being transmitted through the gap 38, which surrounds the knob 14. See col. 5, lines 5-7.

Specifically, Zysnarski discloses that:

Each light source 22 emits light, some of which traverses a light path or optical path from the light source 22 to a gap 38 about a periphery of the knob 14. The light that emanates from the gap 38 about the knob 14 and the affiliated light path may comprise contributions (e.g., rays) from one or more of the following: a generally direct light component 54, a reflective light component 56, and a refractive light component (not shown). The diffuser 34 may refract light incident upon the interior surface 32 at certain angles because of the different indices of refraction of the light diffuser 16 and the surrounding air in the interior region 60, in accordance with Snell's law, as is well known to those skilled in the optical arts. When light leaves the diffuser 16 and enters the exterior, the light may be refracted again. The light diffuser 16 tends to scatter light incident upon the diffuser 16 in addition to refracting it. An interior surface 58 of the knob 14 may reflect light, which ends up being transmitted through the gap 38. In one embodiment, the interior surface 58 may be white or coated with a reflective material (e.g., a metallic material) to maximize the reflective component. Accordingly, maximizing the magnitude of the reflective component 56 may increase the intensity of the light emitted from the gap 38 so long as the light waves combine in a predominately constructive manner.

See col. 4, lines 57-67, and col. 5, lines 1-13; emphasis added.

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Fig. 1 of Zysnarski specifically shows the reflective component 56 of light being reflected from the reflective interior surface 58 of the knob 14. Thus, the knob 14 reflects light, rather than transporting light. Accordingly, Zysnarski clearly fails to disclose at least "*a light rotor*" as recited in claim 1 (emphasis added), and therefore, does not anticipate claim 1.

Further, the knob 14 of Zysnarski also does not extend from the light source 22 toward the light diffuser 16 to a height for light transport. Instead, the light diffuser 16 extends from the light source 22 towards the knob 14. Accordingly, Zysnarski also does not disclose at least "*a light rotor that extends towards the optical light guide to a height necessary for light transport*" as recited in claim 1 (emphasis added), and therefore, does not anticipate claim 1.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1.

Claims 4-9 and 17 depend therefrom and are at least allowable by virtue of their dependency, as well as for the additional features recited therein.

For example, claim 8 recites, in part, "*wherein the optical light guide is fixed relative to the control element*" (emphasis added).

As shown in Fig. 1 of Zysnarski, and as asserted by the Examiner, the optical light guide 16 engages the panel 24. On the other hand, the alleged light rotor (i.e., knob 14) of the control element rotates with respect to the light guide 16.

Accordingly, Zysnarski clearly fails to disclose at least "*wherein the optical light guide is fixed relative to the control element*" (emphasis added).

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Thus, Zysnarski clearly does not anticipate at least claim 8. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of at least claim 8.

Claim Rejections under 35 U.S.C. §103

Claims 1, 2, and 4-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Glienicke (US 6,224,221). Claims 2, 3, and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zysnarski et al. These rejections are respectfully traversed insofar as they pertain to the presently pending claims.

With respect to the rejection of claims 1, 2, and 4-17 under 35 U.S.C. 103(a) as being unpatentable over Glienicke, Applicants respectfully traverse this rejection.

Independent claim 1 recites a control element comprising:

a combined scale and corona illumination, wherein the scale is a part of a panel that is designed to work together with the control element;

an optical light guide formed from a single piece that includes two parts, the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot;

a light rotor that extends towards the optical light guide to a height necessary for light transport; and

a light source located below the light rotor. (Emphasis added.)

As exemplarily illustrated in Fig. 2, the subject application discloses that the light from the light source 9 located below the light rotor 7 is transported through the light rotor 7 into the upper region, where it is coupled to the optical light guide 6 for

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backlighting or illumination of the scale 3 and the corona 5. See, e.g., specification at page 3, paragraph [0017].

In the outstanding Office Action, the Examiner stated that Glienicke discloses:

Glienicke discloses a combined scale and corona illumination, wherein the scale is a part of a panel that is designed to work together with the control element, an optical light guide (e.g., 6, 11) that includes two parts (e.g., 6 & 11), which are partially separated by an annular slot (e.g., Figure 1), such that parts of the panel engage (e.g., 9) or project into the slot, a light rotor (e.g., 1) that extends towards the optical light guide (e.g., 6, 11) to a height necessary for light transport, and a light source (e.g., 5) located below the light rotor (e.g., 1).

See Office Action at page 5, emphasis added.

First, Applicants respectfully submit that Glienicke fails to disclose or suggest at least *"a light rotor that extends towards the optical light guide to a height necessary for light transport"* as recited in claim 1.

Second, Applicants respectfully submit that Glienicke fails to disclose or suggest at least *"an optical light guide formed from a single piece that includes two parts, the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot"* as recited in claim 1.

Accordingly, Applicants respectfully traverse this rejection.

For example, as set forth above, Glienicke fails to disclose or suggest at least *"a light rotor that extends towards the optical light guide to a height necessary for light transport"* as recited in claim 1.

Applicants respectfully submit that the Examiner misinterpreted the features of the *"light rotor"* as being comparable to the overall knob assembly 1 of Glienicke. As shown in Fig. 1, the overall knob assembly 1 clearly is not *"a light rotor that extends towards the*

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optical light guide to a height necessary for light transport; and a light source located below the light rotor" as recited in claim 1 (emphasis added), as recited in claim 1.

Indeed, the Examiner has not responded to Applicants traversal of this position, and has not explained how the overall knob assembly 1 of Glienicke is comparable to the claimed light rotor.

It is noted that, where Applicant traverses any rejections, the Examiner should, if he repeats the rejection, take note of the Applicant's argument and answer the substance of it (see M.P.E.P. § 707.07(f)). Thus, Applicant respectfully submits that the Examiner should have responded to all of Applicant's traversal positions and answered the substance of the arguments (e.g., see M.P.E.P. § 707.07(f)).

Accordingly, Applicants respectfully submit that the outstanding Office Action fails to establish the obviousness of claim 1 over Glienicke. Applicants respectfully reiterate the request for the Examiner to clarify this rejection, if maintained.

Moreover, Applicants respectfully submit that the outstanding Office Action fails to establish that Glienicke discloses or suggests at least "an optical light guide formed from a single piece that includes two parts, the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot" (emphasis added), as recited by claim 1.

The Examiner alleged that the optical light guide is taught by the combination of the light transmitting body 6 and the light transmitting body 11. In the outstanding Office Action, the Examiner acknowledged that Glienicke fails to specify that the first and second optical light guide are formed from a single piece. The Examiner alleged that it would have been obvious to combine the first and second light-transmitting body to be a single piece.

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However, Applicants respectfully submit that the Examiner's stated motivation for modifying the teachings of Glienicke merely is an unsupported conclusory statement, and thus, fails to properly establish a *prima facie* case of obviousness.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (cited with approval in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (April 30, 2007)).

Indeed, Glienicke clearly fails to suggest such a modification. For example, with reference to Fig. 1 of Glienicke, it can be clearly seen that the light transmitting bodies 6, 11 are not partially separated, as recited in claim 1. Instead, the light transmitting bodies 6, 11 are completely separate. Specifically, Glienicke states that:

"the light-transmitting body 6 terminates with its peripheral part 8 in a transparent housing section 9. This housing section 9 includes...a light-transmitting body 11 of the rotatable knob 1 firmly emplaced in the housing section 9 between the scale 10 and the peripheral part 8 of the light-transmitting body 6."

See Glienicke at col. 2, lines 38-41; emphasis added.

Thus, Applicants respectfully submit that the outstanding Office Action fails to establish that Glienicke discloses or suggests at least "*an optical light guide formed from a single piece that includes two parts, the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot*" (emphasis added), as recited by claim 1.

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Moreover, Glienicke does not disclose or suggest that the light transmitting body 6 or the light transmitting body 11 of the housing 9 have an annular slot that partially separates each one into two parts, as recited in claim 1.

Furthermore, Glienicke does not disclose or suggest that parts of a panel engage with such a slot or project into a slot. Thus, Glienicke also clearly fails to disclose or suggest at least *"the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot"* (emphasis added) as recited in claim 1.

Indeed, the Examiner failed to address or respond to Applicants' position that the features of *"the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot"*, as recited in claim 1, are not disclosed or suggested by Glienicke.

It is noted that, where Applicant traverses any rejections, the Examiner should, if he repeats the rejection, take note of the Applicant's argument and answer the substance of it (see M.P.E.P. § 707.07(f)). Thus, Applicant respectfully submits that the Examiner should have responded to all of Applicant's traversal positions and answered the substance of the arguments (e.g., see M.P.E.P. § 707.07(f)).

Thus, Applicants respectfully submit that the outstanding Office Action fails to establish the obviousness of claim 1 over Glienicke.

Accordingly, the Examiner is requested to withdraw this rejection.

Claims 2 and 4-10 depend from claims 1 and are at least allowable by virtue of their dependency, as well as for the additional features recited therein.

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For example, claim 8 recites, in part, "*wherein the optical light guide is fixed relative to the control element*" (emphasis added). As shown in Fig. 1, the alleged optical light guide 11 is not fixed with respect to the control element 1 of Glienicke.

Accordingly, the Examiner is requested to withdraw this rejection.

With respect to rejection of independent claim 11, Applicants respectfully traverse this rejection for somewhat similar reasons as claim 1 above.

For example, claim 11 recites a control element including:

a rotary knob;

a corona substantially circumscribing the rotary knob, the corona being adapted to emit light therefrom;

a scale substantially circumscribing the corona and the rotary knob, the scale being adapted to emit light therefrom;

an optical light guide formed from a single piece having an annular slot provided therein, the annular slot being formed to receive a projection extending from the scale; the optical light guide directing light towards the scale and the corona; and

a light rotor that directs light from a light source towards the optical light guide (emphasis added).

As noted above with respect to claim 1, Glienicke fails to show at least "*an optical light guide formed from a single piece*" as recited in claim 11 (emphasis added).

Moreover, neither of the light transmitting bodies 6, 11 of Glienicke have an annular slot provided therein, whereby the slot receives a projection extending from the scale, as recited in claim 11.

Thus, Glienicke is distinguished from the above quoted feature in that Glienicke fails to show at least "*an optical light guide formed from a single piece having an annular*

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slot provided therein, the annular slot being formed to receive a projection extending from the scale" as recited in claim 11 (emphasis added).

Furthermore, in the outstanding Office Action, the Examiner alleged that Glienicke discloses a combined scale and corona illumination, wherein the scale is part of a panel that is designed to work together with the control element. However, the Office Action failed to establish that Glienicke discloses "*a scale substantially circumscribing the corona and the rotary knob, the scale being adapted to emit light therefrom*" as recited in claim 11 (emphasis added).

For example, referring to col. 2, line 41, Glienicke discloses that the "housing section 9 includes a scale 10." Thus, it is unclear how the scale 10 circumscribes the housing section 9 if the housing 9 includes the scale 10.

For the foregoing reasons, Applicants respectfully submit that claim 11 is not rendered obvious from Glienicke. Claims 12-16 depend therefrom and are at least allowable by virtue of their dependency, as well as for the additional features recited therein. Accordingly, the Examiner is requested to withdraw this rejection.

With respect to the rejection of claims 2, 3, and 10 under 35 U.S.C. 103(a) as being unpatentable over Zysnarski, Applicants respectfully traverses this rejection.

Claims 2, 3, and 10 are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, claims 2, 3, and 10 recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

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For example, claim 10 recites, in part, "*wherein the optical light guide and the light rotor are formed as a single piece*" (emphasis added).

In rejecting claim 10, the Examiner acknowledged that Zysnarski failed to disclose the optical light guide and the light rotor is formed as a single piece. However, the Examiner alleged that Zysnarski suggests that the knob and the light diffuser may appear to be one piece to a user (e.g., column 3, lines 50-55). Emphasis added.

The Examiner alleged that it would have been obvious to make both of the light guide (optical light guide & light rotor) into a single piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

However, Applicants respectfully traverse the Examiner's position, since the proposed modification of Zysnarski clearly would render the prior art invention being modified unsatisfactory for its intended purpose. Accordingly, there is no suggestion or motivation to make the proposed modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Additionally or alternatively, the proposed modification of Zysnarski clearly would change the principle of operation of Zysnarski. Accordingly, the teachings of Zysnarski are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

For example, as shown in Fig. 1 of Zysnarski, and as asserted by the Examiner, the optical light guide 16 engages the panel 24. On the other hand, the

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alleged light rotor (i.e., knob 14) of the control element rotates with respect to the light guide 16.

Thus, the proposed modification of forming the optical light guide 16 and the light rotor (i.e., knob 14) as a single piece clearly would render the device of Zysnarski inoperable, since the light rotor (i.e., knob 14) would no longer be rotatable.

Moreover, as clearly shown in Fig. 2 of Zysnarski, the proposed modification of forming the optical light guide 16 and the alleged light rotor (i.e., knob 14) as a single piece clearly would prevent the alleged light rotor (i.e., knob 14) from being tilted with respect to the optical light guide 16, as shown in Fig. 2.

Thus, the proposed modification of Zysnarski clearly would render Zysnarski unsatisfactory for its intended purpose. Accordingly, there is no suggestion or motivation to make the proposed modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Additionally or alternatively, the proposed modification of Zysnarski clearly would change the principle of operation of Zysnarski. Accordingly, the teachings of Zysnarski are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

For at least the foregoing reasons, Zysnarski clearly fails to disclose or suggest at least "wherein the optical light guide and the light rotor are formed as a single piece" as recited in claim 10 (emphasis added).

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Thus, Zysnarski clearly does not render obvious the features of at least claim 10. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of at least claim 10.

Correction of Attorney Docket No.

Applicants respectfully request that the Examiner correct the Office Action to properly identify the Attorney Docket No. as 1020/0132PUS1.

CONCLUSION

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Martin R. Geissler, Applicants' Attorney at 1.703.621.7140 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3828 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully Submitted,



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